

REMARKS

Claims 1, 4-5, and 7-38 are pending in the current application. In this response, claims 1, 10, 11, 17, 21, 23, 24, 31, 34 and 37 are amended. No new matter is believed to be added by these amendments as all amendments are supported by the specification. Claim 6 has been canceled. Applicant submits that all of the claims are now in a form for allowance.

Claim Objections

The Office Action provides that claim 23 is objected to because of informalities. Specifically, the Office Action provides that for the claim limitation described in claim 23, the specification discloses an inclusive claim limitation (see Office Action, pf. 5). Applicants have amended claim 23 to overcome this objection. Support for amended claim 23 can at least be found in paragraph [0043] of the published application, which provides (in part):

“ . . . Thus, the content control module 100 (FIG. 1) could be configured to require the media content displayed in advertisement area 500 to be related to Company X, or *at least not related to Company X’s competitors*, when Company X’s commercials are displayed in the video area 510.” (Emphasis in italics added.)

Applicant respectfully submits that this amendment has overcome the objection, and, as such, Applicant requests allowance of claim 23.

Claim Rejection – 35 U.S.C. § 112

The Office Action provides that claim 6 is rejected under 35 U.S.C. 112, fourth paragraph, as allegedly being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicants respectfully request to cancel claim 6, without prejudice.

Claim Rejections – 35 U.S.C. § 103

In the Office Action, claims 1, 4-9, and 17-38 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine et al. (US 2002/0004839) in view of Zigmond et al. (US 6,698,020).

Claim 10 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine in view of Zigmond and Birdwell et al. (US 6,108,706).

Claims 11-16 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine in view of Zigmond and Birdwell, further in view of Sahota (US 2002/0010928).

Claim 23 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine in view of Zigmond, further in view of Jeannin et al. (US 2002/0083469).

Applicant first submits that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. See *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness, can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

To overcome these above-noted rejections, Applicants have amended independent claims 1, 10, 17, 21, 24, 31, 34 and 37 to include the limitation (or an equivalent thereof):

displaying the priority event in the video stream in a video area of a screen display of a client device;

displaying an application interface and receiving an activation of an application in an application area of the screen display of the client device;

responsive to receiving the activation of the application, displaying one of the media content instances not excluded by the exclusive trigger in an advertisement area of the screen display of the client device simultaneously with the display of the priority event in the video area of the screen display of the client device and the application interface in the application area of the screen display of the client device.

Applicants submit there is support found for these claim amendments in the specification of the present application at least in paragraph [0040] (pg. 4) and paragraph [0041] (pg. 5) of the published application.

Applicants submit that Wine, or Wine in any combination with Zigmund, Birdwell, Sahota, or Jeannin fail to teach, suggest or make obvious a screen display of a client device having three areas – a video area, an application area, and an advertisement area, where responsive to responsive to receiving the activation of the application, displaying one of the media content instances not excluded by the exclusive trigger in an advertisement area of the screen display of the client device simultaneously with the display of the priority event in the video area of the screen display of the client device and the application interface in the application area.

Therefore, all the limitations of amended independent claims 1, 17, 21, 24, 31, 34 and 37 are not taught, suggest or made obvious to one of ordinary skill in the art over Wine in view of Zigmund. Furthermore, all the limitations of amended independent claim 10 is not taught, suggested or made obvious to one of ordinary skill in the art over Wine in view of Zigmund and Birdwell.

Claims 4, 5, and 7-9 depend from amended independent claim 1 either directly or indirectly. Claims 18-20 depend from amended independent claim 17 either directly or indirectly. Claim 22 depends from amended independent claim 21. Claims 25-30 depend, either directly or indirectly, from amended independent claim 24. Claims 32-33 depend, either directly or indirectly, from amended independent claim 31. Claims 35-36 depend, either directly or indirectly, from amended independent claim 34. And, claim 38 depends from amended independent claim 37. Applicants respectfully submit that each of these

dependent claims are allowable at least because they contain all the limitations of their base claim, which are not taught, suggested or made obvious by the cited references. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Applicants submit that claims 1, 4-5, 7-9, and 17-38 are in a form for allowance.

Claims 11-16 depend, either directly or indirectly, from amended independent claim 10. The Office Action provides that these claims are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine in view of Zigmond and Birdwell, further in view of Sahota. However, as indicated above, Wine in combination with Zigmond and Birdwell fails to teach, suggest or make obvious all the limitations of claim 10. The addition of Sahota fails to correct this deficiency. Further, as claims 11-16 now depend from an allowable base claim, they too are allowable. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Applicants respectfully submit that claims 11-16 are in a form for allowance.

In the Office Action, claim 23 is rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Wine in view of Zigmond, further in view of Jeannin. Claim 23 depends from amended independent claim 21. As indicated above, Wine in view of Zigmond fails to teach, suggest or make obvious to one of ordinary skill in the art all the limitations of claim 21. As claim 23 includes all the limitations of its base claim, the addition of Jeannin fails to correct this deficiency. Further, claim 23 is allowable at least for depending from a now allowable base claim. See *In re Fine*, 5 U.S.P.Q.2d 1569, 1600 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious."). Applicants respectfully submit that claim 23 is in a form for allowance.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int'l Co. v. Teleflex, Inc. (KSR)*, No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary

consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int'l Co.*, at 14, 15. This requirement prevents the use of “the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembicza*k, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants submit that the current construction of the cited references in the manner provided in the Office Action requires hindsight reasoning, which the Federal Circuit has explicitly rejected. *See In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). As stated above, Wine in any combination with Zigmund, Birdwell, Sahota, or Jeannin fail to teach, suggest or make obvious a screen display of a client device having three areas – a video area, an application area, and an advertisement area, where responsive to responsive to receiving the activation of the application, displaying one of the media content instances not excluded by the exclusive trigger in an advertisement area of the screen display of the client device simultaneously with the display of the priority event in the video area of the screen display of the client device and the application interface in the application area. It would not have been obvious to one of ordinary skill in the art to combine Wine with one or more of Zigmund, Birdwell, Sahota, or Jeannin, and the subject matter of the limitations not taught by any combination of these references, to arrive at the presently claimed invention. Applicants earnestly request reconsideration, withdrawal of these rejections under 35 USC 103(a), and allowance of claims 1, 4-5, and 7-38.

Conclusion

Claims 1, 4-5, and 7-38 are pending in the current application. In this response, claims 1, 10, 11, 17, 21, 23, 24, 31, 34 and 37 are amended. Of these pending claims, claims 1, 10, 17, 21, 24, 31, 34 and 37 are independent claims. Since the Applicants respectfully assert that these independent claims are allowable, dependent claims 4-5, 7-9, 11-16, 18-20, 22-23, 25-30, 35-36 and 38 are also allowable. Thus, Applicants respectfully request allowance of all the pending claims in view of the subsequent remarks regarding the above-mentioned independent claims.

No additional fees are believed due beyond the fee for a Request for a One-Month Extension of Time; however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Applicants request the Examiner to contact the undersigned directly at 678-420-9354 if there are any comments or questions in regard to this paper.

Respectfully submitted,

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